

REMARKS

Applicants herein amend claims 1, 14, 26, and 32 for clarity. Such amendments are supported by the specification and claims as originally filed. Reconsideration of the application in view of the amendments and following remarks is respectfully solicited.

FINALITY OF OFFICE ACTION

The Office Action mailed September 6, 2006, is a first action final rejection following a Request for Continued Examination (RCE). This is an improper final rejection, and the finality should be revoked. No justification for the finality of the Office Action was provided.

Before filing of the RCE, Applicants filed a Request for Reconsideration, and received an Advisory Action with detailed comments. Because the application was after a final Office Action, and Applicants recognized the need for a clarifying amendment to the independent claims which would raise new issues for search and consideration, Applicants filed an RCE rather than a Amendment After Final Rejection under 37 CFR 1.116. As stated in MPEP §706.07(b):

However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised.

Further, it would not be proper to make final a first Office action in a continuation-in-part application where any claim includes subject matter not present in the earlier application.

Although Applicants submitted their amendments as a Preliminary Amendment with an RCE, and did not technically therefore receive an Advisory Action refusing entry after final rejection, Applicants acted to speed prosecution recognizing the amendments raised new issues. Applicants should not be penalized for attempting to reduce the Examiner's amount of rework.

In the preliminary amendment, Applicants amended all independent claims to clarify that the identifier is associated with the image bearing product, not the image. Applicants note the Examiner's almost exact recitation of the previous rejection does not acknowledge this change in the claims, and believe the Examiner did not appreciate the substantive change made in the Preliminary Amendment. In fact, no comments regarding this feature of the claims, or the arguments provided about this feature by Applicants, were provided in the Office Action of September 6, 2006.

The amended claims as submitted in the Preliminary Amendment require a different feature than the claims examined before the RCE, raising new issues for search and consideration. A first action Final Rejection is therefor premature, and should be withdrawn.

DEFICIENCIES IN THE OFFICE ACTION

Applicants note the Office Action does not address Applicants' argument as set forth in the Preliminary Amendment at page 8, that:

Independent claims 1, 14, 26, and 32 are herein amended to indicate that a user inputs at least one image into one of the plurality of network connected kiosks, and selects one or more image bearing product for at least one image. The identifier is generated for the image bearing product(s) selected, and is used to retrieve the associated image and generate the selected image bearing product(s) using the image.

The Office Action provides comments on specific features of individual references, but does not address this argument. Thus, the Office Action of September 6, 2006 is incomplete for failure to provide a substantive response to Applicants' argument.

Further, the Office Action at page 2 misstates Meyer et al. Meyer et al. does not have Figs. 1A and 1B, a printer device 20, or a column 4. Thus, the Examiner's comments with regard to Meyer et al. are unclear.

The deficiencies in the Office Action are another reason for the finality to be revoked, as Applicant does not have a complete response from the Patent Office to the Preliminary Amendment and arguments set forth therein.

Despite the deficiencies, which technically require the issuance of a replacement Office Action, in view of the prosecution history and the Examiner's

comments on pages 5-11 of the Office Action, to speed prosecution, Applicants herein provide remarks based on their understanding of the Examiner's rejection set forth on pages 5-11 of the Office Action.

REJECTION UNDER §103(A)

The Office Action rejects claims 1 and 10-14 under 35 U.S.C. §103(a) over Vallmajo et al. (US 6,791,723) in view of Meyer et al. (US 2002/0116278). The Office Action rejects claims 3-7, 9, 16-20, and 22-38 under 35 U.S.C. §103(a) over Vallmajo et al. in view of Meyer et al., and further in view of Redd et al. (US 6,646,754). The Office Action rejects claims 8 and 21 under 35 U.S.C. §103(a) over Vallmajo et al. in view of Meyer et al., and further in view of Liebenow (US 2002/0085840). For at least the following reasons, Applicants traverse each rejection.

Independent claims 1, 14, 26, and 32 claim that the identifier is generated for the image bearing product(s) selected, and is used to generate the selected image bearing product(s) using the image saved on the network from any of the networked kiosks.

As admitted by the Patent Office at page 2 of the Office Action, Vallmajo et al. is not relied upon for the teachings that an identifier is associated with an image bearing product. It is further stated at page 4 that "Vallmajo et al fail to specifically address an identifier associated with the image and image retrieval." Applicants note no mention of associating an identifier with an image bearing product is made by the Patent Office, and is not taught or suggested by Vallmajo et al. Further, Vallmajo et al. does not disclose or suggest generating a selected image bearing product using an identifier.

As admitted by the Patent Office at page 4 of the Office Action:

Meyer et al. disclose generating an identifier *for the at least one image*, wherein the identifier includes information regarding the selected one or more image (code number, par. 21); providing a recipient with the identifier (code number, par. 21); using the identifier to retrieve the at least one image (using the code number to access stored images from the remote site, par. 21); and using the retrieved image (access stored images from the remote site, par. 21). (Emphasis added)

Thus, Meyer et al. associates an "identifier" in the form of a code number with an image. The identifier is not associated with an image bearing product, and the

identifier includes no information regarding desired products. As stated at paragraph 0021, cited by the Patent Office:

[0021] The transaction machine can also print out a receipt for the point-of-sale transaction (block 118). The receipt may provide identifying information about the digital images that were paid for. For example, the receipt may provide a list of the images and a code number for each of the listed images. The code number would make it easier and more secure for the customer to access the stored images from the remote site.

Meyer et al. does not disclose or suggest associating an identifier with an image bearing product, or generating an image bearing product using the identifier, and therefore does not cure the deficiencies of Vallmajo et al.

Redd et al. is directed to a system of photo order management, and backprinting useful information for reordering on the back of the printed images. Redd et al. does not overcome the deficiencies of Vallmajo et al., Meyer et al., or any combination thereof because Redd et al. does not teach or suggest, and is not relied on by the Patent Office for, associating an identifier with an image bearing product, or generating an image bearing product using the identifier.

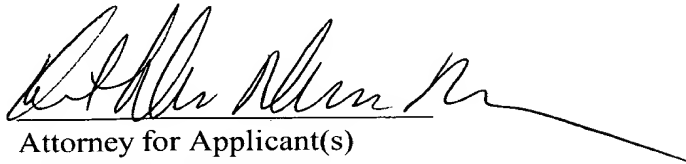
The Patent Office asserts at page 11 of the Office Action that Liebenow is relied on for the teaching of sending a telephonic message. Liebenow does not overcome the deficiencies of Vallmajo et al., Meyer et al., or any combination thereof because Liebenow does not teach or suggest, as admitted by the Patent Office, associating an identifier with an image bearing product, or generating an image bearing product using the identifier.

For at least the reasons set forth above, none of the cited references of Vallmajo et al., Meyer et al., Redd et al., or Liebenow, taken alone or in any combination, teach, disclose, or suggest all of the features of the claimed invention, particularly associating an identifier with an image bearing product, or generating an image bearing product using the identifier. Reconsideration and withdrawal of the rejections are in order, and are respectfully requested.

For at least the above reasons, all of pending claims 1, 3-14, and 16-38 are in condition for allowance. Reconsideration and prompt action in the form of a Notice of Allowance are thus respectfully solicited.

Should the Examiner require anything further, the Examiner is invited to contact Applicants' undersigned representative.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Kathleen Neuner Manne', is written over a horizontal line.

Attorney for Applicant(s)
Registration No. 40,101

Kathleen Neuner Manne/kjw
Rochester, NY 14650
Telephone: 585-722-9225
Facsimile: 585-477-1148

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.